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| 10/669,046      | 09/23/2003  | James F. Curry       | FDN-2593/DIV        | 3996             |

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| EXAMINER |
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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/669,046  
Filing Date: September 23, 2003  
Appellant(s): CURRY ET AL.

**MAILED**  
**JUN 14 2007**  
**GROUP 1700**

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William J. Davis  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 5, 2007 appealing from the Office action mailed April 24, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(4) Status of Amendments After Final**

The amendment after final rejection filed on June 29, 2006 has been entered.

Rejection of claims 2 and 15 under 35 USC, 112, 2<sup>nd</sup> PP has been withdrawn due to the amendment after final filed on June 29, 2006.

This appeal involves claims 1-3 and 15.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is substantially correct since claim 1 neither recites nor claims following narrow limitations:

1. "preferably 5-30%, of a water-insoluble alkylated vinyl pyrrolidone copolymer".
2. "preferably 0.1-2 microns".

3. "preferably 0.002-20%", of a polymeric anionic emulsifier".
4. "a lignin sulfonat, neutralized methyl vinyl ether-maleic acid half-ester or polyacrylic acid with >10% acrylic acid, or salts thereof". "

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct since claims 2 and 5 rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph had been withdrawn. Allowability indicated in the office action of 09/13/05 is moot since new non-final action had been mailed out on 12/20/05.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

|           |              |         |
|-----------|--------------|---------|
| 6,303,131 | Naratanan    | 10-2001 |
| 2,835,654 | Carter et al | 05-1958 |

**Richard J. Lewis, Sr. "Hawley's Condensed Chemical Dictionary", 13th Edition, 1997, "lignin sulfonate" in page 671.**

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan in view of Carter et al.**

Narayanan teaches an aqueous microemulsion system comprising a particulate alkylated vinyl pyrrolidone polymer having a pyrrolidone content > 10% and an anionic emulsifier in table 1 wherein a single phase system is taught. Said alkylated vinyl pyrrolidone polymer is taught at col. 6, line 65 to col. 7, line 8. Also, Agrimers AL25 and AL30 are taught at col. 3, lines 28 and 31 which are also taught in the instant specification, page 3, lines 16-17. Grinding of said alkylated vinyl pyrrolidone polymer under a blanket of liquid nitrogen in order to obtain a particulate solid is taught at col. 7, lines 56-58. Narayanan further teaches that said microemulsion is a dispersion having a particle size of 10 to 100 millimicrons (0.01 to 0.1 micron) at col. 2, lines 15-21) meeting the instant dispersion.

The instant invention further recites polymeric anionic emulsifiers such as lignin sulfonate over Narayanan. However, the instant lignin sulfate are well known emulsifiers as taught by Carter et al (col. 12, line 43).

It would have been obvious to one of skilled in the art at the time of invention to utilize art well known lignin sulfate of Carter et al in Narayanan since Narayanan teaches employing an anionic emulsifier and since said lignin sulfate is one of well known anionic emulsifiers absent showing otherwise.

**(10) Response to Argument**

Appellant asserts that the instantly recited “consisting essentially of” would overcome the rejection based on the art reciting “comprising”.

However, the recitation of “consisting essentially of” alone cannot overcome the rejection based on the art reciting “comprising”. See *In re De Lajarte*, 337 F2d 870, 143 USPQ 256 (CCPA, 1964); When applicant contends that modifying components in the reference composition are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing the basic and novel characteristics of his composition – i.e. a showing that the introduction of these components would materially change characteristics of applicant’s invention.

Furthermore, Appellant asserts (based on 1.132 Declaration) that the presence of N-octyl pyrrolidone in the instant invention transfers the aqueous dispersion of the invention (two-phase system) into a microemulsion (a one-phase system) and that the dispersed particle size of the invention is larger than that of Narayanan. However, Narayanan teaches that said microemulsion is a stable dispersion (even though it appears as a single phase to the naked eye) at col. 2, lines 15-21 as pointed out by the examiner, and thus such assertion has no probative value. Also, the instant claims recite the size of the polymer being less than 10 microns and about 0.1 to 2 microns, and thus the teaching (overlapping particle size, 0.1 micron) of Narayanan (0.01 to 0.1 micron at col. 2, lines 15-21) meets the instant particle size contrary to appellant’s assertion. Also, the 1.132 Declaration itself has little probative value since appellant’s assertion that the instant copolymer particle sizes are much larger than that taught by prior art is unpersuasive since there is an overlapping particle size, 0.1 micron.

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Appellant further states in said 1.132 Declaration that the presence of N-octyl pyrrolidone in the invention composition would change its characteristics materially away from the desired aqueous dispersion (two-phase system) into a detrimental microemulsion, but said statement is based on his own opinion without a particular showing, and thus it lacks credibility. Furthermore, the examples of the prior art already contain said N-octyl pyrrolidone, but they have yielded a dispersion (two-phase system) as discussed above contrary to appellant's assertion.

Appellant asserts that the cited art failed to teach a combination of the named components in defined amounts and physical parameters, but the examiner disagrees since Narayanan teaches such in table 1 and col. 3, lines 36-44 (amounts) and col. 2, lines 15-21 (0.01 to 0.1 micron) and since Carter teaches the lignin sulfonate at col. 12, line 43. Said lignin sulfonate is inherently a polymeric emulsifier. In addition to the cited prior art, the examiner takes Judicial Notice with respect to said lignin sulfonate being polymeric emulsifier based on the enclosed Hawley's Condensed Chemical Dictionary, Thirteenth Edition, page 671, 1997. It teaches that said lignin sulfonate has a molecular weight of 1000-20,000 and said molecular weight is clearly a polymer. Also, the page 9 of the instant specification teaches such molecular weights.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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